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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,284	02/19/2002	Hideo Ando	219507US2S DIV	2763

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EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/076,284	ANDO ET AL.	
	Examiner	Art Unit	
	HUY T NGUYEN	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/348,267.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,4,8</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 28-31 have been renumbered as claims 16-20.

Claim Rejections - 35 USC § 112

2. Claims 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 16-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No.6,353,702. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 16-20 of present application and claims 1-8 of U.S. Patent No.6,353,702 is that claims 1-8 of U.S. Patent No.6,353,702 additionally recite a still picture information file information table that not found in claims 16-20 of the present application. However, it is noted that eliminating a part of a device is obvious to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art to eliminate still information AV table from claims 1-8 of U.S. Patent No.6,353,702 to produce claims 16-20 of the present application.

5. Claims 16-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No.6,389,222. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 16-20 and claims 1-8 of U.S. Patent No.6,389,222 is that claims 1-8 of U.S. Patent No.6,389,222 additionally recite a still picture information file information table and temporary erase information that not found in claims 16-20 of the present application. However, it is noted that

eliminating a part of a device is obvious to one of ordinary skill in the art . Therefore , it would have been obvious to one of ordinary skill in the art to eliminating still information AV table and temporary erase information from claims 1-8 of U.S. Patent No.6,389,222 to produce claims 16-20 of the present application.

6. Claims 16-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28-31 of copending Application No. 10/076,285. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 16-20 of the present application and claims 28-31 of copending Application No. 10/076,285 is that claims 28-31 of copending Application No. 10/076,285 additional recite the information indicating the time that the still video object are recorded. However, it is noted that eliminating a part of a device is obvious to one of ordinary skill in the art . Therefore , it would have been obvious to one of ordinary skill in the art to eliminating the information indicating the time that video objects are recorded from claims 28-31 of copending Application No. 10/076,285 to produce claims 16-20 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 16-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28-31 of copending Application No. 10/076,844. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the difference between claims 16-20 of the present application and claims 28-31 of copending Application No. 10/076,844 is that claims 28-31 of copending Application No. 10/076,844 additionally recite the entry information for start and end still video objects. However, it is noted that eliminating a part of a device is obvious to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art to eliminating the information the entry information for start and end still video objects from claims 28-31 of copending Application No. 10/076,844 to produce claims 16-20 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al (6,242,499) in view of Saeki et al (6,253,026).

Regarding claims 16-20, Kim discloses an recording/ reproducing apparatus (Figs. 2, 3, column 2, 4,5 for recording video objects and control information on and from a optical disk . The control information comprises a search pointer for describes an address of a video group information . Kim fails to teaches information indicating a first still picture and a size for a picture . Saeki teaches and recording/ reproducing apparatus for recording control information with video object intimation, the control information indicating a first picture and a size for picture (fig. 11) . It would have been obvious to one of ordinary skill I the art to modify Kim with Saeki by using the teaching of Saeki for providing the information indicating a first still picture and a size for a picture as control information of Kim thereby allowing accurately accessing and processing the picture information.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Application/Control Number: 10/076,284
Art Unit: 2615

Page 7

872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 2600 TECH CENTER customer service whose telephone number is (703) 306-0377.


HUY NGUYEN
PRIMARY EXAMINER

H.N
January 13, 2003